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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,635	07/02/2003	Craig W. Ball	P05769US01	4611
22885	7590	09/27/2006	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			TRAN, KHOI H	
			ART UNIT	PAPER NUMBER
			3651	

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,635

Applicant(s)

BALL ET AL.

Examiner

Khoi H. Tran

Art Unit

3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE 09/14/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

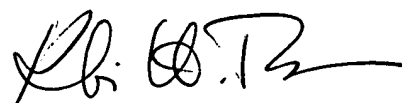
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

The request filed on 09/14/2006 for a Request For Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/613,635 is acceptable and a RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuricht et al. 5,040,132 in view of Harris, Jr. et al. 5,114,128.

Schuricht et al. '132 disclose all elements per claimed method: receiving an intended delivery location with each of a plurality of documents (column 2, lines 55-68); determining a time required to deliver each document to the intended delivery location (column 3, lines 17-21); determining a desired date of receipt (column 9, lines 64-66); determining a time to print each document to allow for the time required to deliver each document on the desired date of receipt (column 10, lines 4-10); obtaining shipping data for each document and printing a label for each document. However, Schuricht '132 is silent as to the specifics of printing the shipping label in-line with printing documents for subsequent mailing.

Harris et al. '128 disclose method of printing mailing labels in-line or on-line with printing documents to be mailed is known (Figure 1, column 3, lines 46-54, paragraph bridging columns 3 and 4, column 8).

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have generated Schuricht '132 label in-line or on-line with printing documents to be mailed, as taught by Harris et al. '128, because it facilitates known means for generating labels for mailing documents.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schuricht et al. 5,040,132 in view of Harris, Jr. et al. 5,114,128 as applied to claim 1 above, and further in view of Boss 4,770,284.

Schuricht et al. '132 modified method discloses all elements per claimed invention. However, it is silent as to the specifics of stapling a shipping label to the document.

Boss '284 teaches name and address can be applied to mailing documents by ink jet printer, or it can be applied first to a label which is to be pasted, stapled or affixed to the mailing documents. Boss '284 shows that stapling shipping label to mailing documents is commonly well known.

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have stapled Schuricht et al. '132 shipping label to the mailing documents because it facilitates another commonly well known means of affixing shipping label to mailing documents, as taught by Boss ' 284.

Response to Arguments

4. Applicant's arguments filed 09/14/2006 have been fully considered but they are not persuasive.

Applicant argued that the combination of Schuricht et al. 5,040,132 and Harris, Jr. et al. 5,114,128 does not disclose utilizing three variables to determine a date to print. This argument is not persuasive.

Applicant argued that Schuricht et al. '132 does not teach determining a time necessary to deliver each document to the intended delivery location because Schuricht et al. '132 selection mode of delivery, such as overnight delivery, does not teach determining a time required to deliver the document. This argument is not persuasive. It is the Office's position that when a mode of delivery is selected, a time necessary for delivery has been determined. For example, when an overnight delivery mode has been selected, a relatively short time of delivery has been determined compared to a regular service. Since Applicant's claims express no specific window of delivery time, any range of time required to deliver an overnight mode item is interpreted to be a time necessary to deliver a document to the intended delivery location.

Applicant argued that Schuricht et al. '132 does not disclose determining a desired date of receipt. Applicant argued that Schuricht et al. '132 simply allows for a user of the system to see the preferred shipping method desired by the receiver. These arguments are not persuasive. It is the Office's position that once a desired date of receipt is known, the determination of a desired delivery receipt has been determined. For example, if the receiver desires an overnight shipping method, the determination of

the date of receipt has been made. It is an overnight delivery receipt with a guaranteed window of two days delivery.

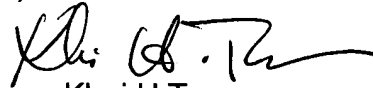
Applicant argued that Schuricht et al. '132 does not teach printing the documents with sufficient time so that the documents are delivered on the desired receipt date. This argument is not persuasive. Applicant's newly amended claims do not support the argument. Applicant argued that Schuricht et al. '132 does not teach determining a printing time. This argument is not persuasive. It is the Office's position that a printing time would have to be determined prior to the actual printing process in order for Schuricht et al. '132 documents to reach the established delivery time. Since Applicant's claims are silent as to a specific printing time for each document, any determined time prior to the printing of the actual documents is interpreted to be a time to print the documents.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi H. Tran whose telephone number is (571) 272-6919. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Khoi H Tran
Primary Examiner
Art Unit 3651

KHT
09/25/2006